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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,686

09/30/2003

Lai Theng Chee

ITL.2003US (P17250)

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47795 7590 03/06/2009  
TROP, PRUNER & HU, P.C.  
1616 S. VOSS RD., SUITE 750  
HOUSTON, TX 77057-2631

EXAMINER

HILLERY, NATHAN

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

03/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/676,686	<b>Applicant(s)</b> CHEE ET AL.	
	<b>Examiner</b> NATHAN HILLERY	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-7 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-7 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to communications: Election filed on 6/9/08.
2. Claims 5 – 7 and 19 – 21 are pending in the case. Claims 5 and 19 are independent.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 5 – 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 5 – 7 recite an algorithm or abstract idea employed in a process that is not embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter. In *Diehr*, the Supreme Court confirmed that a process claim reciting an algorithm could state statutory subject matter if it: (1) is tied to a machine or (2) creates or involves a composition of matter or manufacture.<sup>12</sup> 450 U.S. at 184.

For example, processes involving mathematical algorithms used in computer technology are patentable because they claim practical applications and are tied to specific machines. However, mental processes or processes of human thinking standing alone are not patentable even if they have practical application. In other words, claimed systems that depend for their operation on human intelligence alone does not constitute patentable subject matter.

Further, to expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to make them statutory.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 5 – 7 and 19 – 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Kent et al., (Microsoft Office 2003 Super Bible eBook).

7. **Regarding independent claims 5 and 19**, Kent et al. teach that tasks and events are examples of SharePoint lists. Lists provide a place to store and present data in a convenient, standardized format with some level of customization available. You can add and remove columns in lists and change the order of fields in a list. The information stored in lists is available for export to many Office 2003 applications (p 399, Adding items to existing lists), which meet the limitation of **receiving a first modified task having a first task update, the first modified task corresponding to a first task that is extracted from a first document into a task repository, the first document corresponding to a first application;**

Kent et al. teach that if the attached file is a Word, Excel, or PowerPoint file, the copy of the file received by the recipient is linked directly to the newly created Shared 'Workspace. The recipient can save and work on the file locally and synchronize

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changes with the copy stored in the Shared Workspace (p 413), which meet the limitation of **receiving a second modified task having a second task update, the second modified task corresponding to a second task that is extracted from a second document into the task repository, the second document corresponding to a second application;**

Kent et al. teach that now that you have an Excel spreadsheet linked to a SharePoint list you can add data to the list from within SharePoint or within Excel and easily synchronize those changes (p 407), which meet the limitation of **synchronizing the first task with the first modified task by updating the task repository with the first task update;** and

Kent et al. teach you can also synchronize an Access table that is linked to a SharePoint list (p 407), which meet the limitation of **synchronizing the second task with the second modified task by updating the task repository with the second task update.**

8. **Regarding dependent claims 6 and 20,** Kent et al. teach that the information stored in lists is available for export to many Office 2003 applications (p 399, Adding items to existing lists), which meet the limitation of **updating the first document with the first task update by exporting the first modified task into the first document.**

9. **Regarding dependent claims 6 and 20,** Kent et al. teach that the information stored in lists is available for export to many Office 2003 applications (p 399, Adding

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items to existing lists), which meet the limitation of **updating the second document with the second task update by exporting the second modified task into the second document.**

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN HILLERY whose telephone number is (571)272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan Hillery/

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